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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/086,014
Filing Date: February 28, 2002
Appellant(s): HUGHS-BAIRD ET AL.

Adam H. Masia
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed July 20th, 2007 appealing from the Office action mailed October 13th, 2006 and reply filed January 28th, 2007 including the cancellation of claims 6-7 and 9-10.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

Claims **1-5, 8, 11-18**, and **20-22** are pending in the application and presently rejected over prior art. Claims **6-7** and **9-10** have been canceled in the amendment January 28th, 2008 filed.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection and subsequent to the filing of the Appellant's brief filed on January 28th, 2008 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1 to 10, 18, and 20 under 35 U.S.C. 112, 1st paragraph is withdrawn by the Examiner.

The Examiner's rejections attached to claims 6-7 and 9-10 have been rendered moot and are therefore withdrawn with the Appellant's respective cancellation of the these claims.

(7) Claims Appendix

A substantially correct copy of appealed claims appears on page 31-36 of the Appendix to the appellant's brief. The minor errors are as follows: claims 6-7 and 9-10 have been cancelled through appellant amendment on January 28th, 2008.

(8) Evidence Relied Upon

6,648,754	Baerlocher et al	11-2003
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims **1-5, 8, 18,** and **20** are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al (US 6,648,754)

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

Regarding at least claim **1**, Baerlocher et al teaches a gaming device having a game comprising:

A plurality of values (equivalently offers) greater than zero and payable to the player (Element 100);

a plurality of player selectable masked selections (Elements 108a-108x);

an input device (Elements 44, 50);

a memory device storing a plurality of instructions (Elements 44, 46, 48);

a display device (Figure 1, & Elements 30, 32); and

a processor adapted to communicate with the display device and input device (Figure 2), said processor operable to execute said instructions to operate with said display device and said input device for each play of the game to further (Col 5:31-51):

(a) directly and individually associate said offers with a separate one said selections (Col 6:47-63);

(b) enable a player to select one of said selections (Col 6:47-63);

(c) reveal the value/offer directly and individually associated with the selected selection to the player (Col 6:47-63);

(d) enable the player to accept or reject the revealed value (Col 6:52-63);

and

(e) repeat steps (a) through (d) at least once if said player rejects said revealed value, wherein if the player rejects said revealed values/offers, said revealed value is directly and individually re-associated with one of said masked selections for at least one subsequent selection of step (a) (Col 10:36-44).

(f) if the player accepts said revealed offer, paying said revealed offer to the player (Col 7:5-16)

The offers of Baerlocher are “directly and individually” associated with each of the selections through a cumulative step value as shown in at least figure 4 of Baerlocher. It is additionally noted that though the claim language sets forth “directly and individually” associating the offers with the selections the claim language does not prohibit multiple selections from being associated with a common offer. Hence the claim language defines a mapping wherein each offer may be mapped to a plurality of selections. The defined arrangements encompasses a one-to-many relationship juxtaposed to a one-to-one relationship or otherwise unique relationship between the rewards and offers.

Regarding claims **2-3**, the plurality of values are randomly selected and associated with game selections (Col 7:40-61) from a pool of offers wherein the “pool” of offers includes all tangible game offers.

Regarding claims **4**, Baerlocher teaches that the number of selections may correspond to an equal number of offers (Col 8:9-11; 8:28-38).

Regarding claim **8**, Baerlocher teaches the re-association (reshuffling) of values with selection after the user rejects one selection (Col 10:29-44).

Regarding at least claim **18**, Baerlocher et al teaches a gaming device having a game wherein each play of said game comprises:

- (a) triggering a play the game (Col 6:8-39);
- (b) directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein said plurality of offers are each payable to the player(Col 6:47-51 & Col 7:5-16);
- (c) displaying a plurality player available selections (Figures 4-5);
- (d) revealing one of said offers directly and individually associated with the said selections to the player(Col 6:47-51 & Figure 5b);
- (e) enabling the player to select/pick one of the selections (Col 6:47-51) ;
- (f) revealing one of said offers directly and individually associated with the respective player picked/selected selection to the player (Col 7:29-39 & Figure 4);
- (g) enabling the player to accept or reject said revealed offer (Col 6:47-51);
- (h) providing the offer to the player if the player accepts said offer or if the offer is the last offer(Col 7:5-16); and
- (i) repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player (Col 10:30-44).

Regarding claim **20**, the apparatus/method of Baerlocher teaches revealing a singular value associated with each selection and hence this singular value must represent the maximum and minimum offer (Figure 4).

(10) Response to Arguments

The Appellant's brief fails to set forth an exemplary claim accordingly claim 1 has been selected as an exemplary claim.

(i) Claim Interpretation of Appellant's Exemplary Claim 1

(A) RECITATIONS OF INTENDED USE

The Appellant's claim 1 includes among other elements significant and notable utilization of intended use clauses including those directed to the intended operation of a processor that are not positively recited. For instance the clause "...a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:..." (Claim 1, lines 9-11) references the ability of the claimed invention and specifically the processor thereof "adapted to" communicate with the display device and an input device, "operable to" execute instructions, "operable with" a display device and "to" perform a series of program steps recited in claim lines 12-25. The above references do not limit the claim scope because they do not require the steps to be performed instead suggesting the ability of the device to

Art Unit: 3714

perform steps rather than reflect the actual the execution of those steps (MPEP 2111.04).

The Appellant's claim 1 further contains a "wherein" clause on line three of the same that additionally describes the intended use of offers being payable to the player without a positive recitation paying the offers to the player.

*(B) ABSENT THE RECITATIONS OF INTENDED USE THE PENDING CLAIM
LANGUAGE AND LIMITATIONS THEREOF ARE SIGNIFICANTLY REDUCED*

The remainder of the claim language excluding the appellant's recitations of intended use direct the following:

A gaming device comprising:

a game including:

a plurality of offers(Element 100); and

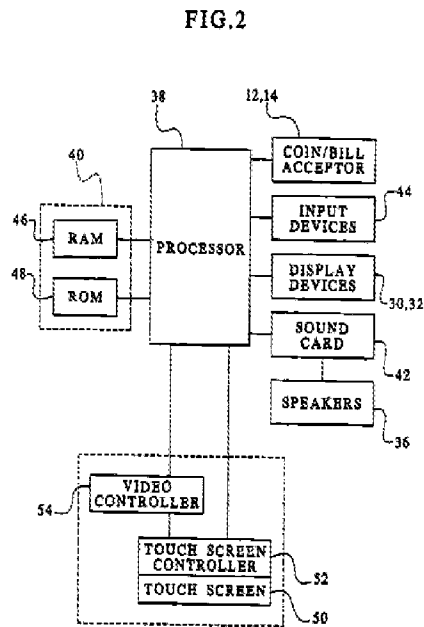
a plurality of player selectable masked selections(Element 108);

a display device(Element 30,32);

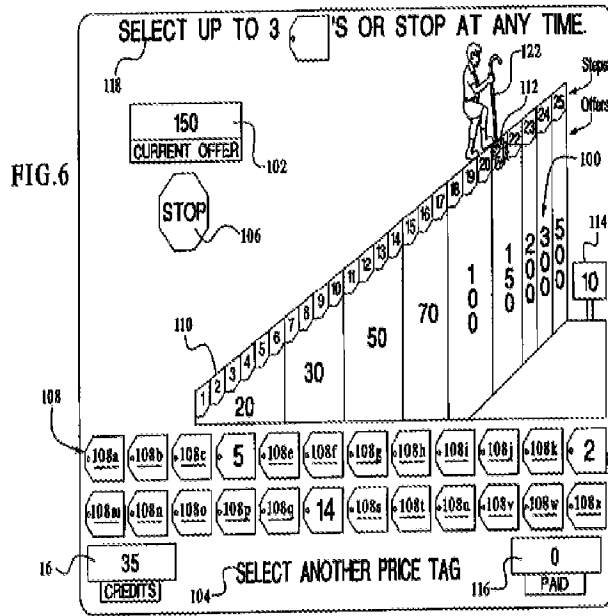
an input device(Element 44);

a memory device storing a plurality of instructions(Element 40); and

a processor(Element 38).



USP 6,648,754 Figure 2



USP 6,648,754 Figure 6

*(C) EVEN IF THE "INTENDED USE" CLAIM LANGUAGE WERE TO BE
 QUANTIFIED AS POSITIVELY RECITED THE CLAIM WOULD CONTINUE TO BE
 ANTICIPATED BY BAERLOCHER*

Appellant's Claim 1	Prior art Of Baerlocher et al US 6,648,754
Claim 1 (previously presented): A gaming device comprising: a game including:	Abstract, Figures 4-6.
(i) a plurality of offers, wherein said plurality of offers are payable to a player, and	Figure 4-6, Elements 100, 102.
(ii) a plurality of player selectable masked selections;	Figures 4-6, Element 108.
a display device;	Figure 2, Element 30, 32.

an input device;	Figure 2, Element 44.
a memory device storing a plurality of instructions;	Figure 2, Element 40, Column 5:27-41.
and a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:	Figure 2, Element 38.
(a) directly and individually associate said offers with said selections,	Col 7:40-8:27, Figures 4A, 4B. As the claim sets forth each selection is mapped to a single offer through the use of steps.*
such that each offer is directly and individually associated with a separate one of the selections,	Figure 4B. Each selection is associated with a single prize offer and all offers are correlated to a selection.**
(b) enable the player to select one of said selections,	Figure 5B.
(c) reveal the offer directly and individually associated with the selected selection to the player,	Figure 5B Element 102.
(d) enable the player to accept or reject the revealed offer,	Figure 5B, Element 106.
(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer,	Element 104 Col 6:51-55.
for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player; and	Offer amount 30 is re-associated with selection elements 108n, 108i, 108e with correlating step values 1, 2, 3 in figures 4a, 4b, 5b. ***
(f) if the player accepts said revealed offer, pay said revealed offer to	Element 106 Col 6:51-55.

the player.	
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* Each offer is directly and individually mapped to a prize offer through the use of corresponding steps.

** Each offer is individually associated with a separate selection as evidenced by the drawing of the prior art wherein no selection is concurrently mapped to multiple offers.

*** Offer "30" previously associated with selection elements 108g, 108o, 108c, and 108l during the first player selection is associated with selection elements 108n, 108i, 108e in the subsequent selection resultant of the user's pick of selection 108g associated with 7 steps.

(ii) Appellant's Brief Sections 1(A) through 1(B) – [Appellant's Brief Pages 13 through 21]:

Appellant's brief sections 1(A) and 1(B) relate to the Appellant's general characterization of the prior art and do not directly address the rejection of claims on appeal. The Examiner's rebuttal of these sections is reserved for Examiner's directed rebuttal of the Appellant's arguments, which rely on these characterizations and is presented in the following sections.

(iii) Appellant's Brief Section 1(C) – [Pages 21 through 22]:

(A) The Appellant's brief suggests that the association of the offers with the selections in a **direct** and **individual** manner provides features that are not allegedly taught by the applied prior art reference of Baerlocher.

The crux to this argument purporting a separation based on a component is the definition and scope of the terms **directly** and **individually**. The Appellant's specification as well as the prior art of Baerlocher fails to mention the terms **direct(directly)** and **individual(individually)** and accordingly fails to provide a clear definition of these terms with relation to a computer gaming device. Additionally, the Appellant's claims fail to clearly define the terms **direct** and **individual** within the context of their presentation. In the submission of the Appellant's reply brief the Appellant espouses that the definition of these terms should be characterized in their plain and ordinary meaning and has cancelled claims included in the appeal that would contradict this interpretation.

With regards to the Appellant's arguments contained within this section the relevant claim passage reads the following.

Claim 1

...

(a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections,

...

(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player; and

...

It should be first noted that claim section (a) describes the association of the offers with the selections (and contrary to the appellant's assertions) is silent regarding the mapping of the selections to the offers. In particular the cited claim language sets forth that for each separate selection there is an offer directly and individually associated therewith however the language does not set forth that these relationships are unique, one-to-one or in any other manner not duplicated through this mapping.

The claim language directed to a separate selection merely precludes the association of multiple offers with a singular selection. The above is fairly presented by the prior art of Baerlocher as applied.

The appellants first challenge on page 22 of the appellant's brief, proposes that the inclusion of steps in the prior art negates any **direct** relationship however such a holding relies on a nebulous definition of the term **direct/directly** that is not supported by the original disclosure of the invention or plain and ordinary meaning of such terminology. The appellant's claimed invention is an electronic gaming device containing a processor, memory, a display and a remainder of implements required to enable the device to function. The very nature of such a device would require a plurality of intervening constructs and components (cables, software, programming variables, ect.) in order to enable one component of the device to communicate with another component of the device. In appellant's claimed invention the selections shown to the player would have to be defined in some manner (presumably data) and then correlated through the use of yet another form of data (presumably a table or pointer) to an offer represented by yet another collection of data by a processor. Yet despite this inherent

elements associated with a computing device the appellant would seemly hold that these required intervening elements would in some manner maintain this claimed **direct** correlation while the use of steps such as present in the prior art of Baerlocher would corrupt such a relationship. Plainly the direct association as claimed by the appellant does not preclude the inclusion of intervening steps because the language does not address such a prohibition while additionally the appellant's own invention would necessitate the inclusion of intervening elements according to at least claim 1. While the claim language is interpreted in view of the specification and the nature of the invention, to maintain in this particular environment that one set of data would be suitable to maintain a direct relationship, however the inclusion of similar of data (the steps of Baerlocher) would violate this relationship poses at best a convenient delineation seemly based on the mere presence of the prior art and abstract to the disclosure of the claimed invention. Applying such a standard as suggested by the appellant would inevitably deprive any ordinary worker in art of the ability to determine the metes and bounds of the invention, is not supported by the disclosure of the application, and following therefrom would represents an improper standard.

As correlated under section (i)(c) above the Examiner maintains that the offers of Baerlocher are directly related to the selections of Baerlocher through the steps of Baerlocher.

The appellant's second challenge on page 22 of the appellant's brief, suggests that the prior art of Baerlocher does not directly and individually reassociate an offer with at least one masked selection for at least one subsequent selection choice by the

player. This assertion however is blatantly contradicted by the teachings of Baerlocher and specifically the correlation as demonstrated above in section (i)(c). Therein referenced above the player offer amount of “30” previously associated with selection elements labeled 108g 108o, 108c, and 108l during the first player selection opportunity is re-associated with selection elements 108n, 108i, 108e in the subsequent selection opportunity resultant of the user’s pick of selection 108g associated with 7 steps. The selections of Baerlocher are directly associated with individual offer amounts through a correlation of steps for a first player selection choice and subsequently re-associated with different offers for a secondary player selection choice. These offers are certainly re-associated with individual selections following a first player election as established herein and the claim language “directly associate” does not bar the inclusion of intervening elements as established above.

(iv) Appellant’s Brief Section 1(D) – [Pages 23 through 24]:

Appellant argues that the prior art of Baerlocher does reveal the offer directly and individually associated with the selection.

The language directly and individually has been addressed in the preceding subsection above enumerated (iii)(A) and will not be repeated herein for the sake of brevity.

The prior art of Baerlocher clearly demonstrates the step of revealing the offers associated with the selection (shown as element 102 of figure 5B) and the subsequent revealing of an offer associated with a subsequent selection (shown as element 102 of

figure 5C). Hence the prior art of Baerlocher does in fact provide the step revealing the offer **directly** and **individually** associated with the selection and the subsequent selection in contradiction to the Appellant's allegations.

(v) Appellant's Brief Section 1(E) – [Pages 25 through 26]:

During prosecution of the application two interpretations of the claimed offers arose and were presented concurrently during prosecution. For the purposes of the appeal only the correlation of the prior art offers to the present claim offers remains. Accordingly Appellant's arguments directed to demonstrating a distinction between the steps of Baerlocher and the prior art will not be addressed by the Examiner in favor of rebutting the appellant's arguments attempting to separate the offer of the prior art of Baerlocher from the offers of the claimed invention.

In subsection (E)(i) on pages 25 through 26 the appellant argues that the offers of Baerlocher are associated with a number of accumulated steps and are divorced of any direct or individual relationship between the offers and the players selection. However, as presented above, for each iteration of the game of Baerlocher each selection, once mapped to its respective value, correlates to a particular offer amount. The accumulation of steps, though present in the prior art of Baerlocher, serves merely as a mapping feature between the player selection and the offer value. The steps values do not change during a particular round of play, meaning the association between the player selectable selection and the offer does not change once the association has been randomly determined and mapped based on that random

determination. In the same manner the appellant's claimed invention randomly determines and maps an association, which is similarly fixed during the round of play (Appellant's specification page 12 lines 21 through 25). Yet despite this and the discussion regarding the scope and weight of the terms "**directly**" and "**individually**" as presented above, the appellant continues to argue in this section that the inclusion of steps, such as those included in the prior art invention of Baerlocher, must be specifically prohibited through the use of the terms direct and individual.

It is submitted to the honorable board that such holding must be in error, and attempts to maintain a delineation between the prior art and the instant application that is not supported by the practiced definitions of the terms direct and individual as set forth by this Application. The appellant has further utilized the term **direct** in an attempt to draw a distinction between a random mapping of values as presented in this application juxtapose to a random mapping including step values. These delineations are not supported by the common definition of these terms or as disclosed by the appellant's specification to be their intended meaning thereby failing to provide any basis for the appellant's proposed distinction.

(vi) Appellant's Reply Brief Section I(A) – [Pages 4 through 7]:

The appellant argues for a narrower interpretation of the term **individually** citing both the appellant's specification and an unspecific reference to a Merriam-Webster dictionary definition. With reference to the definition the appellant submits the following.

2a: of, relating to, or distinctively associated with an individual <an *individual* effort>

2b: being an individual or existing as an indivisible whole

2c: intended for one person <an *individual* serving>

3" existing as a distinct entity • SEPARATE; and

4: having marked individuality <an *individual* style>

With reference to the appellant's citations of their specification the appellant presents the following citations.

A value is associated with each masked selection. The player selects one of the masked selections and the gaming device reveals the value associated with that masked selection. The revealed value is the player's offer. (Page 3, lines 21 to 24).

In one embodiment, once a value is associated with a masked selection, that value may not be associated with another masked selection during a particular bonus round. (Page 13, lines 3 to 5).

The appellant's provided plain and ordinary definition of meaning however, fails to state or support an interpretation the overly narrow interpretation of the term individually as representing a one-to-one correspondence as suggested (reply brief page 2, lines 15-18). The appellant's citation of their specification additionally fails to utilize or otherwise provide a lexicographer's definition of the term **individual**.

As has been well established that it is improper to import claim limitations that are not part of the claims from the applications specification and/or remarks into their claims (MPEP 2111.01(II)). The appellant's reference to the specification and provided

definitions fail to support the overly narrow interpretation of the term **individually** as to be limited to a purely one-to-one relationship because they do not reference the terminology relied upon and the plain and ordinary meaning reflected by the appellant definition does not describe a one-to-one or otherwise unique relationship.

Starting with the paragraph bridging pages 5 and 6 of the appellant's reply brief the appellant point to a an example including selection elements A and B associated with 10 and 20 respectively during an initial assignment and subsequently associated with 20 and 10 respectively citing the claim language of "each offer is directly and individually associated with a separate one of the selection". While the Examiner does not contest that such arrangement would be fairly presented by such an example said example would not fairly represent the true scope the claim language. As shown below the claim language does not establish a two relationship it establishes a one way relationship wherein for each separate selection there is one offer **directly** and **individually** related to said selection. Continuing the appellant's example this would correlate to including an additional selection mapped to a common value as another selection.

Comparison of Appellant's Argued Scope Verses Actual Scope			
	Selection A	Selection B	Selection C
Appellant's 1 st Example	10	20	x
Appellant's 2 nd Example	20	10	x

Art Unit: 3714

Examiner' s	10	20	10
Example			

Appellant's reference to cancelled claims 6, 7, 9, and 10 are considered moot in view of their cancellation

(vii) Appellant's Reply Brief Section I(B) – [Pages 7 through 10]:

The appellant argues for a narrower interpretation of the term **directly** citing both the appellant's specification and an unspecific reference to a Merriam-Webster dictionary definition. With reference to the definition the appellant submits the following.

1a: in a direct manner <directly relevant> <the road runs directly east and west>
 1b: in immediate physical contact
 1c: in the manner of direct variation

With reference to the appellant's citations of their specification the appellant presents the additional following citations.

A value is associated with each masked selection. The player selects one of the masked selections and the gaming device reveals the value associated with that masked selection. The revealed value is the player's offer. (Page 3, lines 21 to 24).

A value is associated with each masked selection and the selections do not initially reveal or display the value associated with each selection. (Page 12, lines 12 to 14).

The game randomly selects values form a pool of differing values and associates these selected values with a plurality of shells as indicated by block 164. (Page 18, lines 3 to 5; Fig. 5).

The appellant argues (page 9 of the appellant's reply brief) the examiner's interpretation that a series of intervening elements would be required to enable the device to function and instead proposes that these elements though admittedly present provide the direct relationship. This argument however is flawed as such an interpretation would lead to enable any process or element in a computer environment that enables the association between the selection and the offer as being direct and would necessarily include the virtual steps of the prior art.

Continuing on the same page the appellant attempts to extend their rationalization of this through the inclusion of a mechanical example. Respectfully this interpretation of claims is not based on a mechanical structure but instead a computer executing software and wherein further the use of the term direct is used to characterize a relationship of data with intervening steps, processes and components. Regardless thereof the appellant proposes the following on page 9 lines 6 through 10 of the appellant's reply brief.

For example, if a generic mechanical device claim states that "object A is directly connected to object B", the Examiner's line of reasoning would conclude that since matter still exists between object A and object B at the sub-atomic level, the two objects are not directly connected despite the express language of the claim.

The appellant's arguments as crafted present and argue the language "directly connected" in a clear shift away from the claim language of directly associate[d]. The arguments following therefrom attempt to argue that the examiner's reasonability or alleged lack thereof based on the connotation of the term *connected* rather than *associated*. Never the less to continue the appellant's line of reasoning: A computer may be directly connected to a monitor through a video cable. Nothing in the phrase

“directly connected” would invalidate this assessment under to the broadest reasonable interpretation because even if the language was intended to preclude any intervening elements the languages fails to address such elements . The same would follow through to the actual claim language (directly associate) because the language presents a correspondence between the selections and the offers without positively reciting that there is an absence of intervening elements between the selection and the offer.

(viii) Appellant’s Reply Brief Sections II and III– [Pages 10 through 12]:

The appellant argues the claim language to support a one-to-one or unique correspondence between the selection elements and the offers however as discussed above in at least sections (iii) and (vi) the pending claim language does not reasonably support such a narrow distinction.

Conclusion

The appellant presents arguments in the attempt to establish a delineation between their claimed invention and the invention of Baerlocher. These arguments however, are commonly reliant on a narrow interpretation of the terms “directly” and “individually”, which is plainly not supported by the appellant’s disclosure or common meaning as shown above. Accordingly it is submitted that the arguments must fail for

Art Unit: 3714

their reliance on an excessively narrow interpretation of these terms and that the pending rejections should be maintained

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Robert Mosser/

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